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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,465	12/09/2003	Jeffrey A. Whitsett	10872/0507287	5274

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FROST BROWN TODD, LLC
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CINCINNATI, OH 45202

EXAMINER

MONTANARI, DAVID A

ART UNIT	PAPER NUMBER
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1632

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	04/11/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 04/11/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.		Applicant(s)	
	10/731,465		WHITSETT ET AL.	
	Examiner		Art Unit	
	David Montanari		1632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-75 is/are pending in the application.
- 4a) Of the above claim(s) 1-38, 41 and 43-75 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39, 40 and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicants arguments and amendments filed 1/11/2007 have been entered.
2. Claims 39 and 40 have been amended.
3. The declarations by Whitsett and Glasser have been considered.
4. Claims 39, 40 and 42 are examined in the instant application.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 39, 40 and 42 remain rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, and 8 of U.S. Patent No. 6,838,428 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other

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because the instant claims are similar to said patented claims, as discussed in the previous office action mailed 7/14/2006

Response to Arguments

Applicants argue in amendment filed 1/11/2007 that they will file a terminal disclaimer when the double patenting rejection is the last remaining rejection. This is not persuasive. Though applicants have stated they will file a terminal disclaimer, the instant rejection is maintained for reasons of record in the office action mailed 7/14/2006.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 39, 40 and 42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

Applicants have amended the instant claim 39 to recite that claimed method of treating pulmonary disease in a subject comprises the administration to "the surface of the airways and alveoli of" a subject. A reading of the instant specification fails to support this amendment to the claim. The specification mentions alveoli and airways in a pathological and morphological sense throughout the working examples but there is not recitation of a method of treatment that would

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involve treating the surface of the airways and alveoli in a patient. To overcome this rejection Applicant would need to provide page and line number where support for this specific means of delivery in the context of treating pulmonary disease in a subject occurs.

Claims 39, 40 and 42 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention for reasons of record in the office action mailed 7/14/2006.

Response to Arguments and Glasser and Whitsett Declarations

Applicants argue in amendment filed 1/11/2007 that neither therapy of the present invention is intended to deliver proteins systemically, but to deliver them to the surface of the airways and alveoli. Applicants continue that various readily available and well-known delivery methods such as aerosol and instillation therapy have been used for a wide variety of disorders and is a standard clinical procedure. Applicants continue that two declarations (Glasser and Whitsett) as well as supporting literature by Hokuto and Ikegami show the feasibility of the claimed method. These arguments are not persuasive. At issue is the breadth of the claimed method, which reads upon treating any pulmonary disease. For example, both lung cancer and asbestos lead to pulmonary disease, however besides the treatment of pulmonary inflammation caused by SP-C deficiency, the specification as filed fails to teach the treatment of any other

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pulmonary disease. In both examples, the cancer and asbestos are chronic effectors of pulmonary disease, they would need to be treated/cured before the pulmonary disease would show any viable improvement in diagnosis. The claimed method is very broad in what is exactly being treated, which from a reading of the specification seems to be the freeing of the airway for respiration, however this is not what is claimed. The specification goes into detail about SP-C deficiency/mutation, its pathology, etiology etc..., however again this is not in the claimed method. The claimed method encompasses the SP-C treatment is an end point treatment for all of the phenotypes that make up pulmonary disease, and this is not the case. Applicants argue that this claimed method is standard clinical practice. This is not a persuasive argument in view of the sheer breadth of the claimed method. The skilled artisan could not envision practicing the claimed method to treat all forms of pulmonary disease if other effectors (i.e. asbestos) exist. Further the art of record provides sufficient teaching that unpredictability exists regarding the practice of the claimed method. The recently provided references by the applicant deal with specific instances of treating a certain pathology involving SP-C/D mutation or deletion and do not encompass the treatment of pulmonary disease in one fell swoop. Thus for reasons of record and above the rejection is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Montanari whose telephone number is 1-571-272-3108. The examiner can normally be reached on M-Tr 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras can be reached on 1-571-272-4517. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


SUMESH KAUSHAL, PH.D.
PRIMARY EXAMINER